

Application No. 09/463,494
Applicant: Manfred T. REETZ, et al
Amendment Under 37 CFR §111 dated June 30, 2004

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Claims 42 and 45 were rejected under 35 U.S. C § 112, second paragraph, as being indefinite. In response, Applicants have adopted the Examiner's suggestions and changed "a mutant hydrolase" to "said mutant hydrolase" in step d) of claim 42 and step e) of claim 45. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

For the record, Applicants emphasize that although the claims were amended to overcome this rejection, and, therefore, might be argued to have been amended for a reason

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substantially related to patentability, a fair reading of the amended claims will reveal that the departures from the previous claims were for clarification purposes only, and the Applicants did not narrow the claims in any material respect. Therefore, Applicants submit that the amended claims are entitled to the full range of equivalents.

Claims 42 and 45 were rejected under 35 U.S.C. §103(a) as being obvious over either of Nakanishi, et al. (N), Hirose, et al. (U-2) or Krainev, et al. (V-2) in view of Williams, et al. (A), Zhou, et al. (U), Leung, et al. (V), Cadwell, et al. (W), Shinkai, et al. (X), Stemmer (V-1) and Zhang, et al. (W-1). In response, Applicants submit that the Examiner has not made out a *prima facie* case of obviousness. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

The rejection as set forth in the Office Action does not address all of the instant claim limitations. Therefore, Applicants submit that the rejection as set forth is legally deficient, and, therefore, the Examiner has not, in fact, made out a proper *prima facie* case of obviousness.

According to *Manual of Patent Examining Procedure* ("MPEP") § 2143:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references

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when combined) must teach or suggest ***all*** the claim limitations.” [Italics in original; bold italics added.]

Step b) of the instant claims requires that:

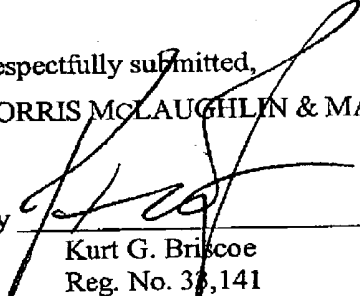
“[the] mutagenic polymerase chain reaction comprises adjusting one or more parameters of the reaction in order to control the number of mutations introduced into said starting hydrolase gene, wherein said one or more parameters are selected from the group consisting of the Mg^{2+} concentration of the reaction, the Mn^{2+} concentration of the reaction, the deoxynucleotide concentration of the reaction and the number of cycles of the reaction.”

The Examiner’s rejection does not in any way deal with this limitation of the present claims. The Examiner has not explained where the cited combination of references teaches or suggests that the mutagenic polymerase chain reaction comprises adjusting one or more of the Mg^{2+} concentration of the reaction, the Mn^{2+} concentration of the reaction, the deoxynucleotide concentration of the reaction and/or the number of cycles of the reaction in order to control the number of mutations introduced into a starting hydrolase gene. As these are limitations of the instant claims, and the Examiner has not dealt with these limitations in the statement of the rejection, the Examiner has not on this record made out a *prima facie* case of obviousness. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

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Early and favorable action is earnestly solicited.

Respectfully submitted,
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment and attachments (9 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: June 30, 2004

By 